

REMARKS

In the Final Office Action, the Examiner rejected claims 1-2, 4-7, 10-11, 15, and 16 under 35 U.S.C. § 102(b) as being anticipated by Tateishi (U.S. Patent No. 5,669,007)¹; and rejected claim 3 under 35 U.S.C. § 103(a) as being unpatentable over Tateishi in view of Bello et al. (U.S. Patent No. 6, 496, 819). Based on the following reasoning, Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. § 102 and § 103(a).

I. **The Rejection of Claims 1-2, 4-7, 10-11, and 15-16 Under 35 U.S.C. § 102(b).**

Claims 1-2, 4-7, 10-11, and 15-16 were rejected under 35 U.S.C. § 102(b) as being anticipated by Tateishi. Applicants respectfully traverse this rejection.

In order to support a rejection under 35 U.S.C. § 102(b), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Tateishi fails to teach each and every recitation of claims 1-2, 4-7, 10-11, and 15-16. In particular, Tateishi at least fails to teach at least “[a] structured document search method for searching a structured document database” including, *inter alia*, “analyzing the accepted search request to generate a search graph including graph nodes based on the logical structure, wherein the graph nodes represent one of a hierarchical-level relationship, sibling relationship,

¹ Although the Examiner rejected claims 1-2, 4-7, 10-11, and 15-16 under 35 U.S.C. § 102(e), Applicants note that Tateishi issued on September 16, 1997, which is more than one year prior to the Applicants' filing date of November 17, 2000. Accordingly, Applicants assume that the Examiner intended to reject these claims under 35 U.S.C. § 102(b) instead.

or ancestor-posterity relationship, and a variable to be embodied is inserted between the graph nodes," as recited in claim 1.

The Examiner asserts² in the Advisory Action mailed on April 27, 2005 that

Tateishi teaches:

'analyzing the accepted search request to generate a search graph including graph nodes based on the logical structure, wherein a variable to be embodies is inserted between the graph nodes' as 'an analysis graph creating section 308, and an analysis graph searching section' (Col. 6, lines 32-33). It should be noted the variable is inserted between the graph nodes corresponds to the cost in Fig. 9 (e.g. between the node HEADER, 1, CS3, and BEGIN, ?, CS5, the Cost2 is inserted . . . Further, Tateishi discloses the cost (i.e. variable) is inserted between the nodes as "the cost is independently assigned to each node and the link" (col. 17, lines 30-33), and the cost assigned to the link is the variable between the graph nodes.

Advisory Action at p. 2. Applicants disagree with the Examiner's characterizations but to expedite prosecution, Applicants have amended claim 1. Tateishi certainly fails to teach at least "analyzing the accepted search request to generate a search graph including graph nodes based on the logical structure, wherein the graph nodes represent one of a hierarchical-level relationship, sibling relationship, or ancestor-posterity relationship, and a variable to be embodied is inserted between the graph nodes," (emphasis added) as recited in claim 1.

Further, Tateishi is directed toward a system whereby a paper document is scanned and matched with predetermined patterns on a line-by-line basis. Abstract and col. 6, lines 45-52. Such scanning and matching of predetermined patterns of a paper document do not constitute a search of a "structured document database," as recited in

² The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

claim 1. The Examiner asserts in the Advisory Action mailed on April 27, 2005 that "the recitation 'structured document search method for searching a structure[d] document database' has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead the process steps or structural limitations are able to stand alone." Applicants respectfully disagree with the Examiner's assertions. As stated in M.P.E.P. § 2111.02 "any terminology in the preamble that limits the structure of the claimed invention must be treated as a claim limitation." Applicants submit that searching a structured document database clearly limits the structure of the claimed invention and therefore must be treated as a claim limitation. Furthermore, the limitation of "generating a search plan for a hierarchical structure possessed by a searched document, in which a search processing procedure for said structured document database is developed from said search graph, said generating the search plan including . . .," is dependent on the structural limitations of the preamble and therefore the preamble must be given patentable weight.

Alternatively, the Examiner alleges that Tateishi does teach the claimed structured document database. The Examiner asserts that:

Tateishi does teach the claimed 'structured document database' as the 'data of the file 424 of a graph stored on the hard disk an[d] expressed by a predetermined data structure,' (col. 18, lines 14-17), and 'the input to the graph search section 310 is the data of the file of a graph stored on the hard disk 404 and expressed by a predetermined data structure' (col. 18, lines 24-27). It is noted the data of the file(i.e. document) is stored on the hard disk with a predetermined data structure (i.e. structure[d] document database).

Advisory Action at p. 2. Applicants respectfully disagree with the Examiner's characterizations. Claim 1 recites the step of "generating a search plan for a hierarchical structure possessed by a searched document, in which a search processing procedure for said structured document database is developed from said search graph, said generating the search plan including . . ." That is, a search processing procedure for the structure document database is developed from the search graph. However, the Examiner interprets Tateishi's teaching of the storage of the graph on a hard disk as the "structured document database. Therefore, according to the Examiner's interpretations, a search procedure for the search graph stored on a hard disk (i.e., structured document database) is developed by the search graph. That is, a search procedure for a search graph is developed by the search graph. Applicants respectfully submit that the Examiner's interpretations of the cited reference are inconsistent and therefore improper. Rather, Tateishi provides no teaching of "generating a search plan for a hierarchical structure possessed by a searched document, in which a search processing procedure for said structured document database is developed from said search graph," as recited in claim 1. For these reasons, claim 1 is allowable over Tateishi.

Claims 4-7 and 10-11 depend from claim 1. As explained, claim 1 recites elements not disclosed by Tateishi. Accordingly, claims 4-7 and 10-11 are allowable over Tateishi at least due to their dependence from claim 1. Applicants therefore respectfully request that the rejection of these claims under 35 U.S.C. § 102(b) be withdrawn and the claims allowed.

Claims 15 and 16, although of different scope, recite elements similar to that discussed above with regard to claim 1. Applicants therefore request the Examiner to

withdraw the rejection of claims 15-16 for at least the same reasons discussed above with respect to claim 1.

II. The Rejection of Claim 3 Under 35 U.S.C. § 103(a).

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Tateishi in view of Bello et al. Applicants respectfully traverse this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claim 3 depends from claim 1. As noted above, Tateishi fails to disclose "analyzing the accepted search request to generate a search graph including graph nodes based on the logical structure, wherein the graph nodes represent one of a hierarchical-level relationship, sibling relationship, and ancestor-posterity relationship, and a variable to be embodied is inserted between the graph nodes," as recited in claim 1. Bello et al. also fails to teach this element of claim 1, and the Examiner has not

asserted otherwise. Rather, the Examiner merely cited Bello et al. for allegedly teaching "selecting, from an applicable plan generation rules, a plan generation rule a cost of which is less than said applicable plan generation rules." OA at p. 5. Claim 3, therefore, is allowable over the Examiner's proposed combination of Tateishi and Bello et al. at least due to its dependence from claim 1.

III. Conclusion

In view of the foregoing remarks, Applicants submit that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 16, 2005

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